

### **REMARKS**

By the above amendment, minor informalities in the specification have been corrected, and the claims have been amended in a manner which is considered to overcome the rejection of the claims under 35 U.S.C. §112, second paragraph, as set forth by the Examiner, noting, for example, that "certain" allowable range has been amended to "set" allowable range. Additionally, independent claims 1, 9 and 16 have been canceled, with dependent claims 2, 10 and 17 being written in independent form and the remaining claims being amended to depend directly or indirectly from such independent claims, it being noted that independent claim 8 has been amended to incorporate the features of claim 10 therein. Also, new dependent claims 24 and 25 have been presented, and applicants submit that the claimed features as set forth in the independent and dependent claims of this application are not disclosed or taught in the cited art, as will become clear from the following discussion.

Also, submitted herewith are proposed drawing corrections to Figs. 8 and 9A and corrected drawings thereof. Acceptance of the corrected drawings is requested.

Applicants note that the present invention is directed to an energy service business for saving energy in any type of energy consumption object facility such as a co-generator as illustrated in Fig. 11 of the drawings of this application and a refrigerator as illustrated in Fig. 13. In accordance with the present invention, in determining savings of the energy consumption object facility, such as production quantity, weather conditions such as temperature and humidity, and other factors which vary a characteristic of energy consumption of the facility referred to in the specification of this application as attribute data are taken into account. In accordance with the present invention as now recited in each of independent claims 2, 8, 10 and 17, past data for the facility regarding energy consumption before taking energy-saving measures is stored in a database in a form correlated with attribute

data regarding variable factors of the energy consumption, such as temperature or humidity, and the measurement effected of energy consumption after taking energy-saving measures, measures the measurement data as correlated with the attribute data as described. Therefore, in calculating the energy curtailment quantities, the calculating means as recited in claim 2, for example, retrieves past data which the attribute data agree within a set allowable range and compares the past data and the measurement data so as to obtain a properly correlated measurement of the energy saving and applicants submit that each of the independent claims of this application clearly set forth the storing of energy consumption before taking energy-saving measures in the database together with attribute data variable factors of the energy consumption and utilizing such correlated attribute data in calculating the energy savings for both the past data and the presently measured data in the manner as described in the specification of this application.

Applicants submit that such features are not disclosed or taught in the cited art, as will become clear from the following discussion.

The rejection of claims 1-6, 8-12 and 16-22 under 35 U.S.C. 102(e) as being anticipated by Yablonowski et al (US 6,535,859) and the rejection of claims 7, 13-15 and 23 under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al, are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To

establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately

address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In applying Yablonowski et al to the claimed invention, the Examiner indicates that Yablonowski et al teach a method and system for maintaining lighting systems and for monitoring energy consumption of the lighting system. Applicants note that Yablonowski et al only discloses a lighting system as a service facility for energy saving, whereas the present invention discloses many types of energy saving facilities or equipment, including not only a lighting system, but as discussed above, a co-generator as illustrated in Fig. 11 and a refrigerator as illustrated in Fig. 13, for example. Furthermore, applicants note that energy consumption of a lighting system does not vary with weather conditions, such as temperature and/or humidity, but rather, the energy saving effect only depends on hours of operation of the system. As such, Yablonowski et al do not disclose collection of energy consumption data of the disclosed lighting system before modification with attribute data such as temperature and storing such information so as to be compared with actually measured data after implementing energy savings procedures with the corresponding attribute data based upon a set allowable range. In accordance with the present invention as described at pages 12 and 13 of the specification in relation to step 15 and pages 26 and 27 of the specification in relation to step 42, a database of past energy consumption data together with attribute data before modification of the energy consumption facility for effecting savings is prepared and is utilized to accurately determine the actual amount of energy savings which varies in accordance with the attribute data. Thus, as now recited in independent claim 2 of

this application, the calculating means which calculates the energy curtailment quantities before and after taking energy saving measures, retrieves past data with which the attribute data agree within a set allowable range, and compares the past data and the measurement data. Applicants note that the other independent claims 8, 10 and 17 recite similar features and applicants submit that Yablonowski et al does not disclose the recited features in the sense of 35 U.S.C. 102 and 35 U.S.C. 103. As such, applicants submit that all claims patentably distinguish over Yablonowski et al and should be considered allowable thereover.

With regard to the dependent claims, applicants note that dependent claim 4 recites the feature that the attribute data represents at least one of temperature and humidity and dependent claims 11 and 18 correspond thereto. Other dependent claims recite specific features which are not disclosed or taught by Yablonowski et al. In fact, with respect to the features of claims 13 and 23, the Examiner has recognized that Yablonowski et al do not teach such features, but contends that it would be obvious to provide such features. The position as set forth by the Examiner represents the principle of "obvious to try" which is not the standard of 35 U.S.C. 103. See In re Fine, supra. Also, as pointed out in the decision of In re Lee, supra, it is not proper to utilize what the inventor has taught against the teacher without citation of appropriate art and a clear basis in the prior art to support an allegation of obviousness. Thus, applicants submit that the dependent claims recite features which further patentably distinguish over Yablonowski et al in the sense 35 U.S.C. 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be considered to be in compliance with 35 U.S.C. §112, second paragraph, and that all claims patentably distinguish over Yablonowski et al and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (389.40083X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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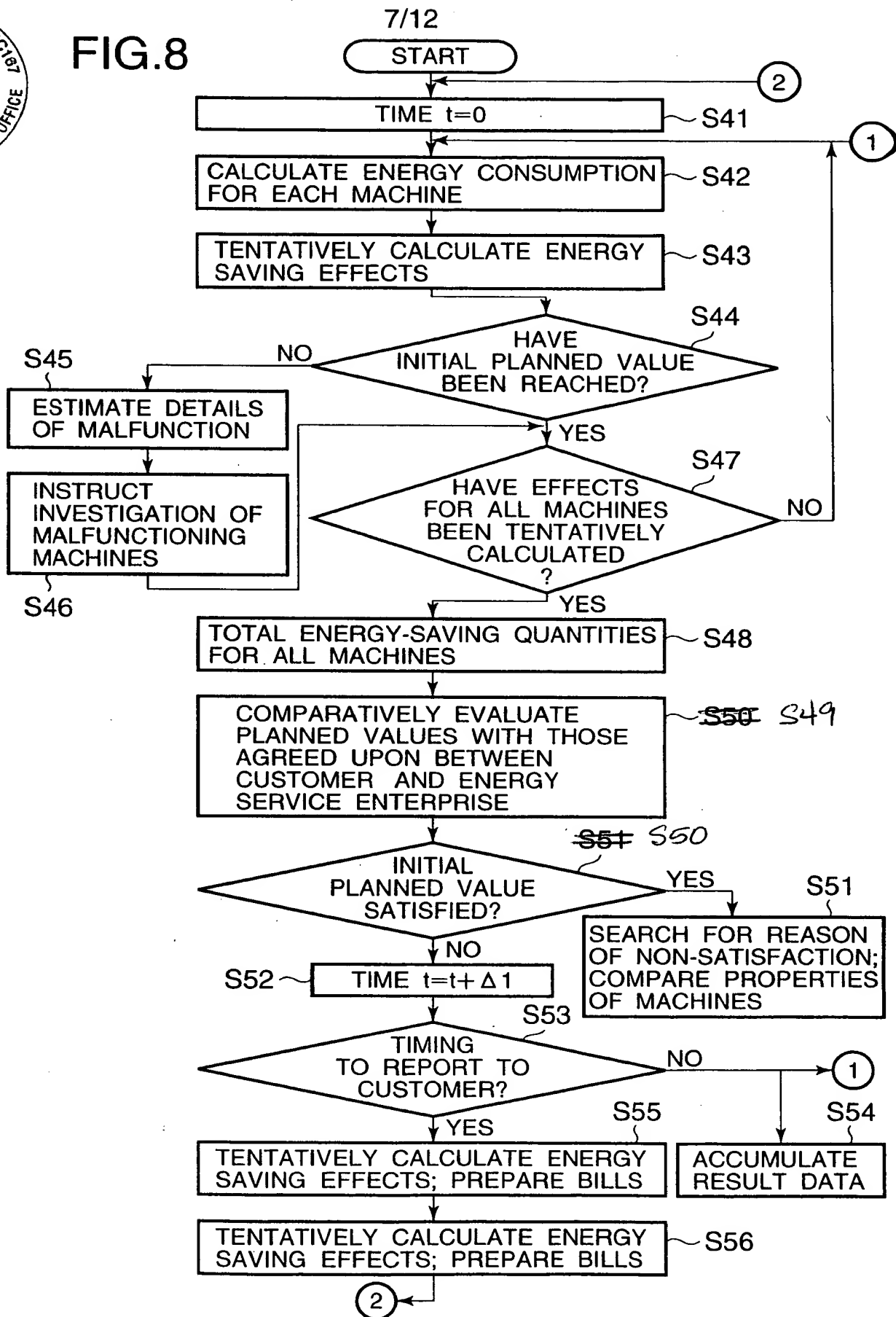
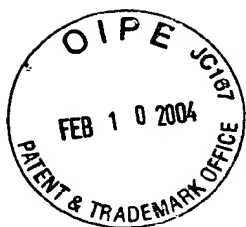
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FIG.8





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FIG.9A

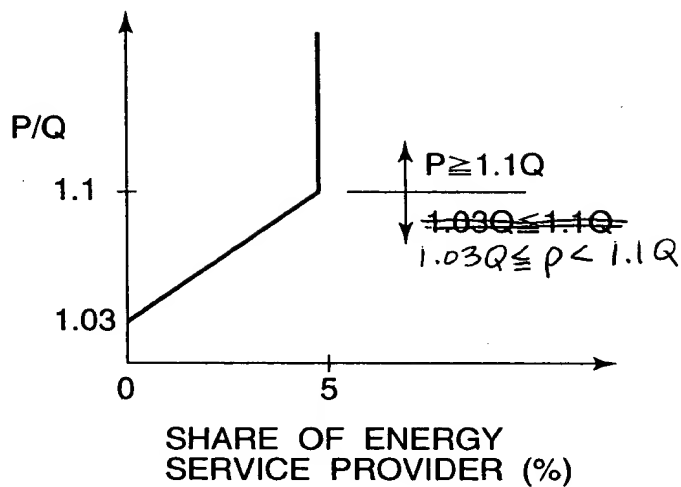


FIG.9B

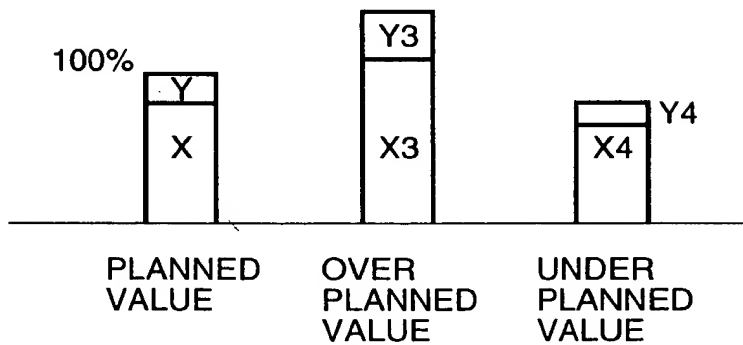
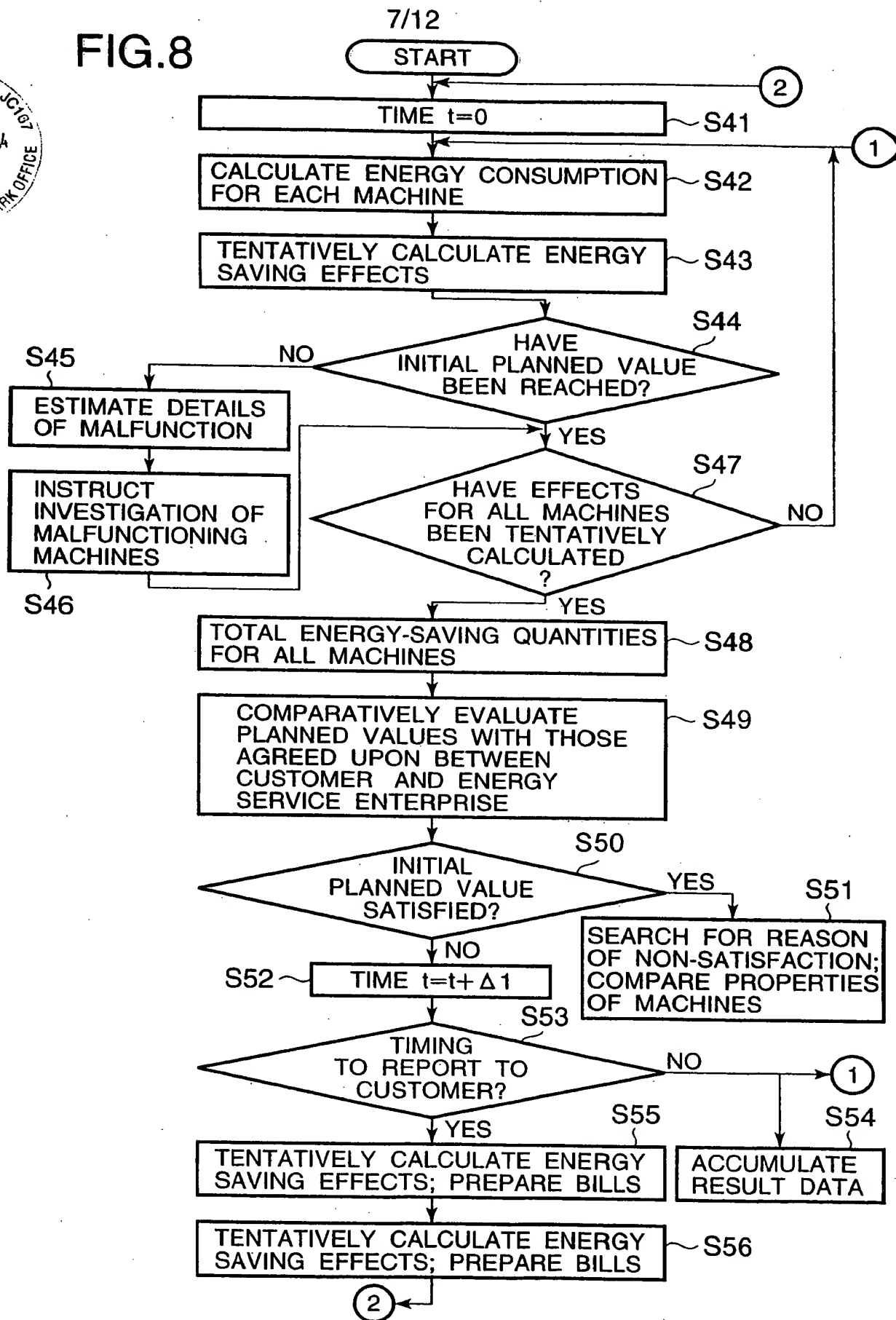






FIG.8



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FIG.9A

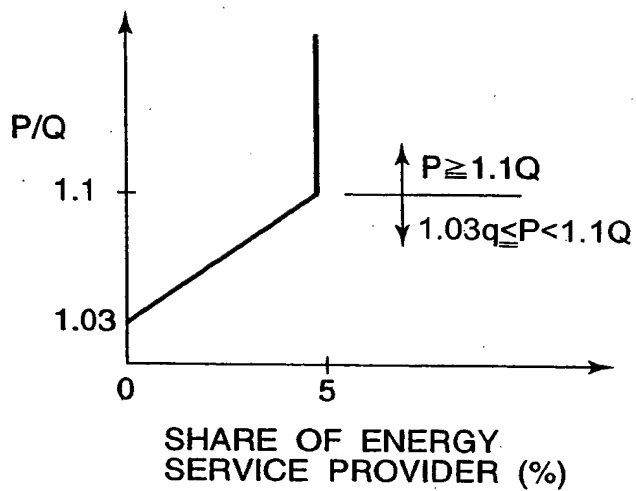


FIG.9B

